

REMARKS

Claims 1-19 are pending in the application. By this Amendment, new claims 16-19 are added.

The Examiner has withdrawn the rejection of claims 1-15 under Seo et al. in view of Horlander. Claims 1, 4, 5, 7, 10, 12, 13 and 15 are rejected under 35 U.S.C. § 102(e) as being anticipated by Margulis (U.S. Patent Publication No. 2001/0021998). Claims 2, 3, 6, 8, 9, 11 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Margulis in view of Levandowski (U.S. Patent No. 6,704,060). Applicant submits the following in traversal.

Claim Rejections Under 35 U.S.C. § 102

Applicant respectfully submits that claim 1 is patentable because Margulis fails to disclose each and every element of the claim. For example, Margulis fails to disclose or suggest a digital television receiver, which converts a tuned digital broadcasting signal into a first transport stream (TS), in combination with other elements of the claim.

In the Office Action, the Examiner alleges that paragraphs 0036 and 0039-0040, and the satellite decoder 132 in Fig. 1, as corresponding to the claimed digital television receiver. Applicant disagrees because there is nothing in Margulis which discloses that satellite decoder 132 converts a tuned digital broadcasting signal **into a first transport stream**, in combination with other elements of the claim. In the section of Margulis cited by the Examiner, paragraphs 0039 and 0040 make no mention of a transport stream being output by the satellite decoder 132.

Even if assuming *arguendo*, that the Examiner is characterizing Margulis as inherently disclosing the satellite decoder 132 as outputting a transport stream, Applicant submits that such a characterization is unsupportable. “In relying upon the theory of inherency, the examiner must

provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”

MPEP 2112(IV) quoting Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Further, it is well established that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” Id. quoting In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); see In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In the present application, the Office Action does not provide a basis in fact and/or technical reasoning to reasonably support the determination that the satellite decode 132 outputs a TS, necessarily flows from the teachings of Margulis. Rather, the satellite decoder 132 may equally likely output an analog video stream that is not a transport stream, and thus, the claimed digital television receiver, which converts a tuned digital broadcasting signal into a first TS, is not disclosed in any way, by Margulis.

For at least the above reasons, claim 1 is patentable.

For reasons similar to those submitted for claim 1, claim 10 is patentable.

Claims 4, 5, 7, 12, 13, and 15, which depend from claim 1 or 10, are patentable for at least the reasons submitted for their respective base claims.

Claim Rejections Under 35 U.S.C. § 103

Claims 2, 3, 6, 8, 9, 11, and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Margulis in view of Levandowski (U.S. Patent No. 6, 704,060).

Claims 2, 3, 6, 8, 9, 11, and 14, which depend from claim 1 or 10, are patentable for at least the reasons submitted for the respective base claims and because Levandowski fails to make up for the deficiencies of Margulis.

Applicant adds new dependent claims 16-19 to better define the invention.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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